



UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

Paper No. 25

Amin & Turocy LLP
1900 East 9th Street
24th Floor National City Center
Cleveland, OH 44114

COPY MAILED

NOV 02 2004

OFFICE OF PETITIONS

In re Application of: :
James Cisar : DECISION ON PETITION
Appl. No. 09/921,103 : UNDER 37 CFR 1.183
Filed: August 2, 2001 :
Atty. Docket No. TELNP120USA :

This reissue application is before the Office of Patent Legal Administration, for consideration of the petition under 37 CFR 1.47(b), filed April 20, 2004. This petition is properly treated pursuant to 37 CFR 1.183.

Petitioner requests waiver of the rule (presumably §1.172) that requires that the inventor sign any supplemental declaration in a broadening reissue application.

The petition is dismissed.

BACKGROUND

37 CFR 1.172 requires that a reissue oath/declaration be made by the inventors, except as otherwise provided (§§ 1.42, 1.43, 1.47), where the scope of the claims of the original patent is being enlarged.

This reissue application, which seeks to broaden the scope of the claims, was filed with signature of sole inventor James Cisar on the original declaration. A supplemental declaration under 37 CFR 1.175(b)(1) was required by the examiner in the Office action of August 12, 2003. A supplemental declaration, filed October 24, 2003, was not accepted by the examiner. See Office action mailed January 22, 2004.

In response, applicant filed the instant petition. The petition states that an executed Supplemental Reissue Application Declaration executed by Glenn Frankenberger on behalf of assignee Symbol Technologies, Inc. is enclosed. However, no such declaration was found among the papers received with the petition on April 20, 2004.

DECISION

35 U.S.C. 251, which is directed to reissue, does not address the signature requirements of a declaration in reissue. 37 CFR 1.172 requires that a reissue declaration be made (and signed) by the inventors, except as otherwise provided (§§ 1.42, 1.43, 1.47), where the scope of the claims of the original patent is being enlarged. 37 CFR 1.175(b)(1) requires that:

"For any error corrected, which is not covered by the oath or declaration submitted under paragraph (a) of this section, applicant must submit a supplemental oath or declaration stating that every such error arose without any deceptive intention on the part of the applicant."

37 CFR 1.175(b)(1), taken in conjunction with 37 CFR 1.172, requires a supplemental declaration to be signed by all of the inventors (in this instance, there is one inventor). This is because all oaths or declarations necessary to fulfill the rule requirements in a reissue application are taken together collectively as a single oath or declaration. Thus, each oath and/or declaration must bear the appropriate signature of the inventors. See *In re Hayes*, 53 USPQ2d 1222 (Comm'r Pat. 1999).

37 CFR 1.183 permits, in an extraordinary situation, waiver of a rule which is not a requirement of the statute, where justice requires such waiver, and applicant has requested such a waiver of the requirement that the 37 CFR 1.175(b)(1) supplemental declaration be signed by the inventor.

The instant petition is accompanied by an appropriate showing that the inventor is unavailable. A supplemental declaration, signed by the assignee may be accepted as though it was signed by the inventor as required by 37 CFR 1.175(b)(1) taken in conjunction with 37 CFR 1.172. However, the supplemental declaration, signed by assignee (corporate counsel) is not among the papers received April 20, 2004.

CONCLUSION

1. In view of the above, the present petition to waive 37 CFR 1.172 is dismissed.
2. A supplemental declaration under 37 CFR 1.175(b)(1), which may be signed by the assignee (pursuant to the above decision), is required to complete the petition and the application.
3. Any request for reconsideration of this decision must be submitted within **TWO (2) MONTHS** from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request would be titled "Renewed Petition under 37 CFR 1.183."
4. Further correspondence with respect to this decision should be addressed as follows:

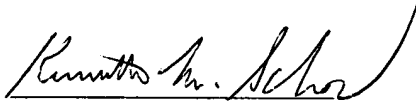
By mail: Mail Stop Petition
 Commissioner for Patents
 P.O. Box 1450
 Alexandria, VA 22313-1450

By FAX: (703) 872-9306
 ATTN: NANCY JOHNSON
 SENIOR PETITIONS ATTORNEY

By hand: Effective June 5, 2004, patent correspondence delivered by hand or delivery services, other than the USPS, to the Customer Window must be addressed as follows:

U.S. Patent and Trademark Office
220 20th Street S.
Customer Window, Mail Stop _____
Crystal Plaza Two, Lobby, Room 1B03
Arlington, VA 22202

5. Telephone inquiries related to this decision may be directed to Nancy Johnson, Senior Petitions Attorney at (571) 272-3219.



Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration